

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of : Before the Board of Appeals
Kaoru Tsukamoto et al. : Appeal No.:
Serial No.: 10/730,095 : Group No.: 3715
Filed: December 9, 2003 : Examiner: K. Hu
Conf. No.: 2690

For: KARAOKE SERVICE METHOD AND SYSTEM BY MOBILE DEVICE

REPLY BRIEF

U.S. Patent and Trademark Office
****Via e filing****
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Date: January 13, 2009

Sir:

In response to the Examiner's Answer dated **November 13, 2008**, Appellants hereby submit this Reply Brief.

1) Statement of Grounds

Appellants respectfully submit that the Statement of Grounds during prosecution of this application have been in part incomplete, and inconsistent.

In the Final Office Action dated May 7, 2007, the Examiner cited and relied upon the Naples et al. reference (U.S. Patent Application Publication No. 2002/0162445) to

newly reject the pending claims. However, as stated on page 12 of the Appeal Brief dated December 6, 2007, the Examiner very generally asserted on page 3 of the Final Office Action that paragraphs 7, 11, 48-50, 56-62, 78, 87-91, 93, 107, 112-118, 195-199, 206-211 and 214 of the Naples et al. reference (U.S. Patent Application Publication No. 2002/0162445) variously disclose the features of claim 6. The Examiner did not identify the elements of the Naples et al. reference that had been specifically interpreted as the features of the claims.

In the Request for Reconsideration dated August 3, 2007, Appellants asserted that the Examiner failed to identify in the Final Office Action the elements of the Naples et al. reference that had been specifically interpreted as the features of the claims. Responsive to the Request for Reconsideration dated August 3, 2007, the Examiner further asserted in the Advisory Action dated August 16, 2007, that paragraphs 48, 49, 97 and 98 disclose the features of claim 6.

In the Supplemental Request for Reconsideration dated September 5, 2007, Appellants again traversed the final rejection and again asserted that the Examiner failed to identify the elements of the Naples et al. reference that had been specifically interpreted as the features of the claims. In the Advisory Action dated September 17, 2007, the Examiner merely asserted that the arguments as presented in the Supplemental Request for Reconsideration were unpersuasive, without identifying the elements of the Naples et al. reference that had been specifically interpreted as the

features of the claims.

Accordingly, during prosecution of this application **prior to Appeal**, the Examiner failed to identify the elements in the figures and/or specification of the Naples et al. reference that had been specifically interpreted as the features of the pending claims, particularly claim 6 for example.

However, **for the first time during prosecution**, the Examiner has stated beginning on page 4 of the **Examiner's Answer** that server 30/shared storage 30a, audio output subsystem 27, and interactive karaoke system 10 in Fig. 1A of the Naples et al. reference have been respectively interpreted as the memory, sound generator and multimedia processor of claim 6. The Examiner has **for the first time during prosecution** specified in detail the manner in which the Naples et al. reference has been relied upon to reject claim 6. The Examiner has **for the first time during prosecution** relied upon Manual of Patent Examining Procedure (MPEP) section 2114 to support and/or explain the rejection in view of the Naples et al. reference, also raising for the first time the issue of structure versus functionality with respect to claim language.

As set forth in MPEP section 706.07: *"Before final rejection is in order a clear issue should be developed between the examiner and applicant.... The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be*

developed, if possible, before Appeal... In making the final rejection, all outstanding grounds of rejection.....must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal..." (our emphasis added).

Contrary to the provisions and guidelines as set forth in MPEP section 706.07, the Examiner failed to develop clear issues prior to Appeal. That is, the Examiner failed to identify prior to appeal the elements of the Naples et al. reference that had been specifically interpreted as meeting the features of claim 6. Prosecution of this application and the record with respect to this application prior to appeal are thus incomplete. The outstanding grounds of rejection were not clearly developed by the final rejection to the extent necessary so that Appellants were able to readily judge the advisability of appeal. Substantial guesswork was thus necessary to formulate a response to the final rejection, and to prepare an Appeal Brief. Moreover, in view of the positions newly presented by the Examiner, the grounds of rejection as presented in the Examiner's Answer dated November 13, 2008, are materially different than the grounds presented in the final rejection dated May 7, 2007. Appellants thus have not been afforded full and fair hearing, and clear issues have not been developed prior to appeal. Additionally, the Board was not fairly apprised of the Examiner's position. Appellants thus respectfully submit that the Final Office Action dated May 7, 2007, is improper, and should be withdrawn.

2) 35 U.S.C. 112, first paragraph, Enablement Rejection

The Examiner has made reference on page 3, lines 15-19 of the Examiner's Answer to paragraph [0055] of the present application (as published in U.S. Patent Application Publication No. 2004/0241632).

Appellants respectfully submit that the Examiner has misread the content of paragraph [0055]. That is, paragraph [0055] of the published application should be interpreted to mean that once the Reset Event as shown in Fig. 8 is initiated, all previous events displayed before initiation of the Reset Event are cleared. In other words, in view of paragraph [0055] of the published application, the following sequence occurs sequentially: 1) events are displayed, 2) a Reset Event is initiated, and 3) all of the events displayed previous to initiating the Reset Event are cleared.

In contrast, the Examiner has interpreted paragraph [0055] of the published application to mean that all previous events are firstly cleared, and then the Reset Event is executed. Clearly, this interpretation of paragraph [0055] of the published application by the Examiner does not logically follow, because execution of the Reset Event would be unnecessary if all previous events were cleared prior to initiating the Reset Event.

Appellants respectfully submit that one of ordinary skill should readily understand paragraph [0055] of the published application to describe the following procedure in sequential order: (1) the Reset Event is initiated, and thereafter (2) all previous events

displayed before initiation of the Reset Event are cleared. There should be no confusion with respect to the specification and the claim language. Appellants respectfully submit that claims 8 and 15 are enabled, and that this application is thus in compliance with 35 U.S.C. 112, first paragraph.

3) Rejection of Claims 6-12 Under 35 U.S.C. 102(e)

The Examiner has for the first time during prosecution stated beginning on page 4 of the Examiner's Answer that audio output subsystem 27 and interactive karaoke system 10 in Fig. 1A of the Naples et al. reference have respectively been interpreted as the sound generator and the multimedia processor of claim 6. The Examiner has thus apparently asserted that audio output subsystem 27 of the Naples et al. reference executes karaoke events according to the karaoke event data and responds to receipt of synchronization data embedded within song data by sending an interrupt signal to interactive karaoke system 10, and that interactive karaoke system 10 executes karaoke events in time order in synchronization responsive to receipt of the interrupt signal, so as to anticipate claim 6 under 35 U.S.C. 102(e).

However, audio output subsystem 27 in Fig. 1A of the Naples et al. reference is not described or even remotely suggested as sending an interrupt signal to interactive karaoke system 10 responsive to synchronization data embedded within song data. Moreover, the Naples et al. reference does not disclose or even remotely suggest that

interactive karaoke system 10 executes karaoke events in time order in synchronization responsive to receipt of an interrupt signal output by audio output subsystem 27, as would be necessary to meet the features of claim 6.

In support of this rejection, the Examiner has relied upon *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997), to apparently disregard and/or ignore that the functionality of the elements of claim 6. The Examiner has asserted that the structure of claim 6 is indistinguishable from the prior art.

Appellants respectfully submit that the Examiner has misapplied *In re Schreiber* in this case. Particularly, the functionality of the features of claim 6 are not inherent in the Naples et al. reference.

That is, audio output subsystem 27 in Fig. 1A of the Naples et al. reference is described in paragraph [0056] as producing sound audible to user 16. Audio output subsystem 27 is further described in paragraph [0114] of the Naples et al. reference as including components for reproduction of sound under control of processor 12c. No further detail with respect to audio output subsystem 27 is set forth in the Naples et al. reference. It should thus be readily clear that the Naples et al. reference does not describe or even remotely suggest that audio output subsystem 27 responds to receipt of synchronization data embedded within song data to send an interrupt signal to interactive karaoke system 10, as asserted by the Examiner. An interrupt signal is not identified in the Naples et al. reference. Contrary to the Examiner's apparent assertion,

the features of claim 6 are not disclosed or inherent in the Naples et al. reference.

Appellants respectfully remind the Examiner that all the features of a claim must be considered together as a whole. Functionality of claim language cannot be disregarded. For example, it is well settled under 35 U.S.C. 112, sixth paragraph, that a claim may recite merely the function of an element, without narrowly specifying the structure or the manner in which the element carries out the recited function.

(Appellants however do not suggest that claim 6 should be interpreted under 35 U.S.C. 112, sixth paragraph.) The Examiner's apparent disregard of the functionality of claim 6 in this case is not supported by *In re Schreiber*, and thus is clearly improper.

Accordingly, Appellants respectfully submit that claims 6-9 distinguish over the Naples et al. reference as relied upon by the Examiner, and that the rejection of claims 6-9 is improper for at least these above reasons, in addition to the reasons as set forth in the Appeal Brief dated December 6, 2007.

Appellants also respectfully submit that claim 13 distinguishes over the Naples et al. reference for at least somewhat similar reasons as set forth above. The Examiner has **for the first time during prosecution** stated beginning on page 5, line 19 of the Examiner's Answer that Fig. 16 of the Naples et al. reference shows MIDI mapping playback processes as described in paragraph [0005] that is interpreted as "generating an interrupt signal responsive to the synchronization data embedded within the song data", as in claim 13. However, paragraph [0005] of the Naples et al. reference merely

describes in general MIDI streams that are multi-tracked for various musical instruments, that these files tend to be small and compact, and that the MIDI streams typically require some form of wave table or FM synthesizer chip to generate their sounds. Paragraph [0005] of the Naples et al. reference does not disclose or even remotely suggest generation of an interrupt signal responsive to synchronization data embedded within song data.

On page 6, lines 5-8 of the Examiner's Answer, the Examiner has apparently asserted that the act of a user selecting to start the playing of the apparatus shown in Fig. 1A of the Naples et al. reference may be interpreted as generating or being the interrupt signal of claim 13. However, this position as apparently taken by the Examiner does not logically follow. In particular, such selection by a user to start the playing of the apparatus in Fig. 1A can not be interpreted as generating an interrupt signal **responsive to synchronization data embedded within sound data**, as would be necessary to meet the features of claim 13. The features of claim 13 are not disclosed or inherent in the Naples et al. reference. Accordingly, Appellants respectfully submit that the mobile karaoke service method of claim 13 distinguishes over the Naples et al. reference as relied upon by the Examiner, and that this rejection of claims 13-19 is improper for at least these reasons, in addition to the reasons as set forth in the Appeal Brief dated December 6, 2007.

Conclusion

For all the foregoing reasons, Appellants respectfully submit that claims 6-19 are patentable over the cited prior art. Therefore, Appellants respectfully request that claims 6-19 be allowed and that this application be passed to issue.

In the event that there are any outstanding matters remaining in the present application, please contact Andrew J. Telesz, Jr. (Reg. No. 33,581) at (571) 283-0720 in the Washington, D.C. area, to discuss these matters.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment for any additional fees that may be required under 37 C.F.R. 41.20 or 37 C.F.R. 1.17 and 1.136(a), or credit any overpayment, to Deposit Account No. 50-0238.

Respectfully submitted,

VOLENTINE & WHITT, P.L.L.C.

A handwritten signature in black ink, appearing to read 'A. J. Telesz, Jr.', with a stylized flourish at the end.

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